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17 August 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Conversive, Inc.

Serial Nos. 78240383 and 78240385

Kent E. Baldauf, Jr. of The Webb Law Firm, P.C. for
Conversive, Inc.

Linda M. Estrada, Trademark Examining Attorney, Law Office
104 (Chris Doninger, Managing Attorney).

Before Seeherman, Rogers, and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On April 22, 2003, applicant (Conversive, Inc.)
applied to register two marks, ASSISTED RESPONSE AGENT
(Ser. No. 78240383) and ASSISTED RESPONSE (Ser. No.
78240385), in typed or standard character form, on the
Principal Register for goods ultimately identified as
follows:

Computer programs, namely an interactive natural
language processing knowledge base used to build and

customize interactive conversational mechanisms in the form of an animated or virtual character which assists [sic], answer questions and provide information to users of web sites, for use in real-time Internet relay communications platforms in Class 9.¹

The applications are based on applicant's stated bona fide intention to use the marks in commerce.

The examining attorney refused to register the marks on the ground that the marks ASSISTED RESPONSE AGENT and ASSISTED RESPONSE are merely descriptive of the goods. 15 U.S.C. § 1052(e)(1). After the examining attorney made the refusals final, these appeals followed. On March 16, 2006, the board granted the examining attorney's request to consolidate the appeals. Inasmuch as the records and

¹ In its requests for reconsideration, applicant offered conditional amendments that were accepted by the examining attorney but did not result in the allowance of the applications. In their appeal briefs, the examining attorney and applicant refer to the goods in the 78240383 application as they are set out above. Accordingly, although the amendment was stated to be conditional, it is clear that applicant and the examining attorney have treated this identification as the operative one, and we have done so also. In the 78240385 application, applicant refers to the earlier identification of goods:

Computer programs, namely an interactive natural language processing knowledge base used to build and customize interactive conversational mechanisms which assist, answer questions and provide information to users of web sites, for use in real-time Internet relay communications platforms.

The brief goes on to explain that the amendment "was dependent upon allowance by the Examining Attorney" (Brief at 2 n.1). The 78240385 conditional amendment also specified that the web sites were "relating to higher education admissions and student loan information." The outcome of this case does not depend on which version of the identification of goods we consider and we will refer to the relevant portion of the identifications of goods in our discussion.

issues are similar, we will refer to the record in the 78240383 application unless we specify otherwise.

The examining attorney's position (Brief at unnumbered p. 4) is that "the mark ASSISTED RESPONSE AGENT conveys to consumers that goods are used for providing assisted responses through an agent. The mark ASSISTED RESPONSE conveys to consumers that a function of the goods is the provision of assisted responses." The examining attorney relies on dictionary definitions and Internet and electronic database articles to support her refusals. Applicant maintains that "the words 'assisted,' 'response' and 'agent' do not describe Applicant's software product. Likewise, the various third party articles do not use the words to describe a product of the type offered by Applicant under its mark." Brief at 4.

The examining attorney has included with her first Office action definitions of the terms in the marks:

Assisted - To give help or support to, especially as a subordinate or supplement; aid.

Response - 1. The act of responding. 2. A reply or an answer.

Agent - 1. One that acts or has the power to act. 2. One empowered to act or to represent another. *An author's agent; an insurance agent.* 3. The means by which something is done or caused; instrument.

The examining attorney also included this definition of "agent" with the final Office action: "a software routine that waits in the background and performs an action when a specified event occurs. For example, agents could transmit a summary file on the first day of the month or monitor incoming data and alert the user when a certain transaction has arrived."

The examining attorney submitted various excerpts from the Internet and an electronic database of articles that show use of the term ASSISTED RESPONSE. We set out some examples below with emphasis added.

Pilner.net **Assisted Response** System is multi-platform compatible. CRM system designed to help you quickly respond to incoming e-mail. Capabilities such as bulk mailing, bounce detection, and extensive reporting. *Assists* the operator in selecting the proper *response* for each e-mail, from a library of preconfigured *responses*.
www.scripts.com

Insight RT - Knowledge Management
Use of these automated channels (such as e-mail auto-response, web self-help, customer feedback, online surveys, etc.) is significantly less expensive than an agent-**assisted response**.
www.realmarket.com

Numerous applications within EnsemblePro - including predictive dialing, email auto and **assisted response**, coordinating voice and data transfers and screen pops.
www.tmcnet.com²

² Similar information was contained in the *Business Wire* articles of November 12 and 19, 2002.

If Edify E-Mail only understands part of a message, it will route it to a live agent with a suggested response for the part it did understand. For messages which need live interaction, Edify E-Mail offers **assisted response** capability as well as an authoring tool, complete with response repository capabilities. www.phoenixcti.com

Firepond's Answer ... enables Saga to process incoming emails from its customers and web site visitors faster and more efficiently with the direct and **assisted response** functionality in Answer, its email management and automation product.

Business Wire, December 6, 2001.³

All responses are now stored in a single response library that is used both by the Intelligence Engine for automated responses as well as by the Agent Desktop for CSR **assisted responses**.

Business Wire, June 26, 2002.

The cost of an automated e-mail transaction is less than 10 percent of the cost of an agent-**assisted response**.

ASAP, February 1, 2001.

Chordiant also announce[d] the availability of Chordiant Automated Response and Chordiant **Assisted Response**.

Software World, January 1, 2001.

Chordiant Knowledge Base uses a sophisticated knowledge engine to deliver the most relevant answers to consumer questions and delivers these responses via

³ "[W]e believe that communications have changed dramatically during the past fifteen years such that by now it is by no means uncommon for even ordinary consumers (much less sophisticated doctors and researchers) to receive news not only via tangible newspapers and magazines, but also electronically through personal computers. Thus, it is much more likely that newswire stories will reach the public because they can be picked up and 'broadcast' on the Internet. In short, while we are not saying that newswire stories are of the same probative value as are stories appearing in magazines and newspapers, we think that the situation has changed such that said newswire stories have decidedly more probative value than they did" previously. In re Cell Therapeutics Inc., 67 USPQ2d 1795, 1798 (TTAB 2003).

Automated Response, **Assisted Response** or Live Response applications.

"Company Profile - Chordiant," *CRM Advocate* website.

NetworkDirect's Eagle Email Introduces Eagle Response; Email **Assisted Response** System Designed for Businesses of Any Size.

Business Wire, October 30, 2000.

Existing storage resources are frequently stretched to meet increasing application demands. To avoid outages, limits can be defined to trigger manual, automated, or automation-**assisted responses**.

ASAP, May 1, 2003.

Repair and maintenance of the systems are reportedly supplemented by a customer assistance center that users anywhere in the U.S. can reach by dialing a toll-free number. Known as the Computer-**Assisted Response** for Emergency Service, the hotline provides a means for remotely answering customer questions and diagnosing systems problems.

ComputerWorld, January 4, 1982.

The customer service solutions emerging to fill this niche have their roots in several disciplines in computer science. They're enjoying a resurgence in applications including knowledge management, user-interface design, case-based reasoning, and good old-fashioned FAQ lists. Most of these solutions involve one or more of three types of technologies:

- a knowledge base with access to experts and a system to present the collected questions online;
- an email management system that can include some level of automated or **assisted response**;
- live chat.

Sims, "You Asked For It," *NewArchitect* website.

Powered by Banter's Relationship Modeling engine (RME), the leading natural language for CRM applications, Reply v4.5 provides unmatched accuracy and ease of use for intelligent response, **assisted response**, and rules-based routing.

Banter website, Press Release, June 5, 2001.

The examining attorney also points to applicant's literature that describes its products.

The Call Center is ground zero for your customer care... But you now have a new challenge. The Internet. Your customers are going there. You know that there are big cost-saving opportunities. But shouldn't there be a way to lay that last mile of railroad track that divides these two essential functions? Shouldn't you be able to use all of your human, data and systems resources in an online environment and gain the best of both worlds? Now you can.

The AssistedResponseAgent Solution.

AssistedResponseAgent is a revolutionary product that for the first time integrates all of the human, process and data resources of the Call Center with the cost savings and scalability of the Internet.

Automatic escalation to a live online CSR.

AssistedResponseAgent has all of the features and capabilities of AnswerAgent. But it provides more as well. For those companies that want to provide that level of customer service that only human beings are capable of, the AssistedResponseAgent uses Conversive's patent pending escalation process to seamlessly refer any question not immediately answerable by the Agent's NLP [natural language processing] engine to a CSR [customer service representative]. The CSR receives the question through Conversive's advanced message controller... CSR's are provided with a highly advanced interface that includes short cuts, editing capabilities and suggestions from our NLP engine. Once the reply is sent, the engine takes over the conversation again, and continues to answer every question that it can.

Based on this evidence, the examining attorney concludes that the marks ASSISTED RESPONSE and ASSISTED RESPONSE AGENT are merely descriptive of applicant's goods.

Applicant, on the other hand, has responded to this evidence by arguing that the "mark 'ASSISTED RESPONSE AGENT' may convey a 'response' that is assisted in some way. However, it does not describe a software product that enables the development of an animated or virtual character for interacting with users of a web site in a conversational matter." Brief at 6. See also 78240385 Brief at 5. Regarding the examining attorney's evidence, applicant makes several observations (Brief at 7-8):

Specifically, in the article "Concerto Software Launches EnsemblePro 5.0," the words "assisted response" are used in connection with coordinated voice and data transfers and screen pops. In the article "Firepond's eService Performer Helps Saga Manage Interaction with "Silver Surfers"; Top UK Web Site for Over-50s Has Complete View of its Customers," the words "assisted response" are used in a discussion of the processing of incoming e-mails in an e-mail management product. In the article "E-Mail Management Technologies: A Purchaser's Primer; Technology Information," the words "assisted response" are used in a discussion of automated e-mail message systems. The article "NetworkDirect's Eagle Email Introduces Eagle Response; E-mail Assisted Response System Designed for Businesses of Any Size" describes a system for reducing time for e-mail replies by using pre-developed messages to customer questions. The article "maximize SAN and NAS ROI with SRM: matching application requirements with appropriate storage resources enables administrators to fully realize the value of networked storage; storage resource management," the words "assisted response" are used in connection with notification of instances where data storage capacity is surpassed. In the article "Firepond Delivers Intelligent Multi-Channel Contact Center with New eServicePerformer 2002; Combines fast deployment with advanced intelligence and easy integration," the words "assisted response" are used

in the discussion of a customer assistance product for e-mail responses. The article "E-Mail Management Technologies: A Purchaser's Primer; Technology Information" uses the words "agent-assisted response" to describe a method of sending e-mail responses to e-mail inquiries with human involvement. The article "Chordiant Knowledge management System; Management News and Products; Brief Article; Product Announcement" refers to words "assisted response" in a product name. This likewise appears to be product for responding to e-mails in a written form. The article "Marks Debut in DP; Savin Comes Out With Two OA Systems," the words "computer-assisted response" are used in connection with a hotline for remote repair and maintenance problems.

Applicant also argues (Brief at 9) that in the *CRM Advocate* article the "term is used to describe the asserted outdated approach of having a human 'agent' handle the process" and, in the *Concerto* article, the term is "used to describe automated voice and data transfers for the EnsemblePro product sold to multimedia contact centers." In addition, applicant maintains that the "Phoenix CTI site includes a description of a product called 'Edify E-Mail.' It is noted that this e-mail product 'offers assisted response capability' due to its ability to suggest response to humans responding to an e-mail." Brief at 10.

We begin our analysis by noting that a mark is merely descriptive if it immediately describes the ingredients, qualities, or characteristics of the goods or services or if it conveys information regarding a function, purpose, or

use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). See also In re Nett Designs, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

A term is merely descriptive if it describes a single significant quality or property of the goods. In re Oppedahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) ("A mark is merely descriptive if it consists merely of words descriptive of the qualities, ingredients or characteristics of the goods or services related to the mark. Thus, a mark is merely descriptive if it immediately conveys knowledge of a quality or characteristic of the product. A mark may be merely descriptive even if it does not describe the full scope and extent of the applicant's goods or services") (citations and internal quotation marks omitted). See also In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987) and Meehanite Metal Corp. v. International Nickel Co., 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959). In descriptiveness cases, the test is not whether potential customers can guess what the goods or services are when they consider the mark in the abstract. Instead, we must consider the mark in relation to the goods or services to

determine if the term is merely descriptive. Abcor, 200 USPQ at 218.⁴

At this point, we look at applicant's goods because we must determine the question of descriptiveness in the context of these goods. Applicant's goods are computer programs, namely an interactive natural language processing knowledge base used to build and customize interactive conversational mechanisms which assist, answer questions and provide information to users of web sites. These programs link automated responses with human interaction. Applicant's literature indicates that its program involves a computer program that responds to a customer's problem with a series of questions. However, it has the capacity "to seamlessly refer any question not immediately answerable by the Agent's NLP [natural language processing] engine to a customer service representative." When the representative is dealing with the customer, the program provides the representative with "short cuts, editing capabilities and suggestions" to assist the representative in responding to the customer. After the representative resolves the question that the program could not answer, applicant's program takes over the process again.

⁴ We have not considered applicant's cited non-precedential board opinions. TBMP § 103 (2d rev. 2004).

Therefore, applicant's programs assist representatives to provide a response to customers. In addition, applicant's software includes an agent function where not only does applicant's software act as an "agent" for the business but it also waits in the background and performs an action when a specified event occurs such as responding to specific consumer inquiries.

In the field of customer service, the term "assisted response" has traditionally been used to describe programs that assist representatives or programs that respond to customers. Applicant's literature (Denial of Reconsideration attachment) describes the evolution of the customer service center.

Customers increasingly choose the Internet as their first point of customer contact. This should save companies money, since the Internet provides the single best opportunity to provide excellent service to customers in a scalable, repeatable way. Unfortunately, most companies are not servicing their customers well on the Internet, so customers resort to other, more expensive channels such as telephone and email...

Our solutions provide a highly flexible customer interface that guides your customers through their problems with the same type of conversational process that a CSR would use. We provide your customers with web pages, forms, graphics, and data as appropriate. We can solicit information from your customers and write that information to the appropriate database or CRM systems, so that it will be available in the appropriate form for further action.

The term "assisted response" is used to describe various computer programs that assist customer service representatives in responding to customer's inquiries. For example, the *NewArchitect* website refers to three solutions to customer service

- a knowledge base with access to experts and a system to present the collected questions online;
- an email management system that can include some level of automated or **assisted response**;
- live chat.

Applicant's programs combine the Internet with a live chat. Another program, Pilner.net **Assisted Response** System, "assists the operator in selecting the proper response for each e-mail." Other sites, www.realmarket.com and www.tmcnet.com, also refer to an "assisted response" by a human agent. The Edify E-Mail program is an email program that will route a message to a live agent with a suggested response. The program "offers assisted response capability." www.phoenixcti.com. The Firepond software also has "assisted response functionality." *Business Wire*, December 6, 2001. The *Banter* engine, which is also a natural language engine for customer relations management applications, features an assisted response feature.

While applicant quibbles with the examples that the examining attorney has introduced into the record, the

evidence nonetheless remains relevant to the question of descriptiveness here. Several examples involve an email system with a live response feature. This system is similar to applicant's Internet system with a live response feature. Furthermore, in order to establish a prima facie case of descriptiveness, it is not incumbent on the examining attorney to establish that an applicant's term is used by others on goods that are identical to applicant's. The question is whether potential purchasers, when they view applicant's goods, would understand that its mark describes a feature or characteristic of the goods. Here, the examining attorney has shown that various customer service management tools, including software that has a live response feature, use the term "assisted response." This evidence is relevant to understanding how potential purchasers of applicant's computer programs would understand the term ASSISTED RESPONSE.

While applicant points out that its marks are not found in the dictionary, we cannot agree with its conclusion that the terms are "made up and arbitrary." Brief at 4. The words clearly have a meaning that would be relevant to applicant's goods, and the evidence shows that others use the term "Assisted Response" in a descriptive manner. While applicant appears to agree that "Assisted

Response" "may convey a 'response' that is assisted in some way," applicant argues that the term "does not describe a software product that enables the development of an animated or virtual character for interacting with users of a web site in a conversational manner." Brief at 6.

However, as we indicated earlier, to be descriptive, a mark does not have to describe the full scope and extent of the applicant's goods. Oppedahl & Larson, 71 USPQ2d at 1371. Applicant's mark is descriptive of a feature of applicant's goods inasmuch as it immediately informs prospective purchasers of the fact that its programs have an assisted response feature.

We also emphasize that the definitions of applicant's terms ASSISTED RESPONSE and ASSISTED RESPONSE AGENT are themselves evidence of the descriptiveness of the term. Indeed, applicant's programs assist customer service representatives to respond to customers and the program acts as an agent or representative of the company. The evidence also makes it clear that the term "Assisted Response" itself is used in the customer service industry. The terms ASSISTED RESPONSE AGENT and ASSISTED RESPONSE immediately inform prospective purchasers that the program assists a company's employees who are responding to

Ser. Nos. 78240383 and 78240385

customers. When we view the marks in this context, we conclude that the marks are merely descriptive.

Decision: The examining attorney's refusals to register the marks ASSISTED RESPONSE and ASSISTED RESPONSE AGENT on the ground that the marks are merely descriptive of the involved goods are affirmed.